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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARDNER G. COURSON,
VINCENT J. MIRAGLIA,
BLANE A. ERWIN,
and PATRICK T. O'DONNELL

Appeal 2009-001491
Application 10/673,050
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING ¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Gardner G. Courson et al. (Appellants) filed a Request for Rehearing of the Decision to affirm the rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention, and to enter a new ground of rejection of claims 5-12 under 35 U.S.C. § 103(a) as being unpatentable over the admission in the Appellant's Specification and Newell.

In accordance with 37 C.F.R. § 41.52(a)(1), the Request includes certain points, in particular, that the Appellant believes the Board misapprehended or overlooked in reaching its Decision. We have reviewed the Request in its entirety but do not find that the Appellant has shown the Board to be in error in deciding to affirm the rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention. Our reasons are enumerated in the DISCUSSION section below.

We will, however, modify the decision by withdrawing the new ground of rejection of claims 5-12 under 35 U.S.C. § 103(a) as being unpatentable over the admission in the Appellants' Specification and Newell.

² Our decision will make reference to the Appellants' Request for Rehearing (filed Nov. 23, 2010, "Request") and the BPAI Decision (mailed Sep. 27, 2010, "Decision").

DISCUSSION

In the Decision, we found in agreement with the Examiner that claims 1-4 were indefinite under 35 U.S.C. § 112, 2nd paragraph, because it is unclear what statutory class they fall into.

We were not persuaded by the Appellants' argument that claims 1-4 were directed to an apparatus and that "[e]ach element clearly falls into the apparatus classification, so the whole invention must then also into the apparatus classification" (App. Br. 18). We found the Appellants' argument to be overly narrow and not commensurate in scope with what is claimed. Claim 1's recitation of an entry field and a menu does not require a graphical user interface, as the Appellants seemed to argue (*see* App. Br. 18), we stated. Further, we noted that contrary to the Appellants' own argument, the Appellants construed the discovery production mechanism as a "computer-implemented process" (*Id.*) and, if we adopted this construction, claim 1 would comprise elements and a step of using these elements, causing the claim to be indefinite on the ground that it does not reasonably apprise those skilled in the art of the statutory class of invention the claim is directed to. Further, we found no other element but "storage" was recited in claim 1. Since an apparatus requires plural parts or devices, it would be unreasonable to construe the claim 1 to require an apparatus, as the Appellants argued. Decision 5-7.

As in the Appeal Brief, the Appellants again argue that the claims are directed to an apparatus.

The Appellants argue that the claim recitation of a "view" requires a GUI, which is structure, and that the Board erred by not finding that a GUI

was required. Request 5-6. The Appellants cite paragraph [0051] of the Specification and emphasize that when the entire claim limitation “an entry field available on a plurality of views not directly related to discovery to request collection of discovery requests” is considered in light of the Specification (as the Appellants addressed in the Reply Brief), “[o]ne skilled in the art that has reviewed the specification and considered it in trying to determine the meanings of the elements would conclude that the elements relate to a GUI, which is classically an apparatus.” Request 5-6.

First, the passage at paragraph [0051] of the Specification discusses interface screen shots. There is no mention of a “GUI,” per se. The passage discusses what Figures 99 and 100 “illustrates.” They are example. There is no indication that the invention as claimed is limited to what is “illustrated.” Second, the Appellants’ argument is not commensurate in scope with what is claimed. During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Whether or not claim elements “relate” to an apparatus disclosed in the Specification that is not expressly recited in a claim is not the standard. Limitations, such as a GUI, that may appear in a specification but not recited in a claim are not normally to be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (“The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.”). Lastly, there is no evidence on the record of the understanding one of ordinary skill would necessarily get from reading the claims in light of the Specification as the Appellants assert. Attorney argument cannot take the place of record

evidence. *See also In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989).

The Appellants also argue that the Board erred by finding that the Appellant construed “discovery production mechanism” as a computer implemented *process*. Request 6. The Appellants contend that this was not the case and that this element requires a computer. The Appellant cites [0052] of the Specification in support. Notwithstanding that we continue to find the Appellants were arguing the phrase to be indicative of a process, even if we would agree that the Appellants meant to argue that the phrase suggested a computer, the argument would nevertheless not be commensurate in the scope with what is claimed. The claims do not require the discovery production mechanism be a computer implementing a process. The claims do not mention a “computer,” let alone a computer implementing a process

CONCLUSION

We have carefully considered the arguments that the Appellants have set forth in the Request but, for the foregoing reasons, we do not find them persuasive as to error in deciding to affirm the rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

We will, however, modify the decision by withdrawing the new ground of rejection of claims 5-12 under 35 U.S.C. § 103(a) as being unpatentable over the admission in the Appellants’ Specification and Newell.

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Application 10/673,050

GRANTED-IN-PART

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